

REMARKS

The Examiner mailed a Notice of Non-Compliant Amendment under 37 CFR 1.121 on April 11, 2007, stating that “[t]he response filed January 11, 2007 is non-compliant because while the applicant listed 11 related applicants [sic] and patents, the applicant objected to and did not identify specific claims of those applications or patents which may present double patenting issues with the instant application claims.” This is the second Notice of Non-Compliant Amendment mailed by the Examiner, and in fact, is identical to the Notice of Non-Compliant Amendment mailed December 11, 2006. That is, it appears that the Examiner dismissed Applicant’s reply filed on January 11, 2007, without even acknowledging or addressing Applicant’s arguments set forth therein.

Because Applicant believes the continued use of a Notice of Non-Compliant Amendment under 37 CFR 1.121 is improper, Applicant has separately and concurrently filed a Petition under 37 CFR 1.181 seeking Director review of (1) the appropriateness of a Notice of Non-Compliant Amendment under 37 CFR 1.121, regarding the reply filed on September 7, 2006, and (2) the appropriateness of Examiner’s broad request made in the Requirement for Information to identify specific claims of those applications or patents which may present double patenting issues with the instant application claims and that such a request is not consistent with the scope of 37 CFR 1.105.

As the Examiner did not address the arguments set forth in the previous response filed January 11, 2007, these arguments have been repeated herein below. Applicant respectfully disagrees with the Examiner’s continued use of a Notice of Non-Compliant Amendment under 37 CFR 1.121. Furthermore, Applicant maintains that the reply filed September 7, 2006, was fully responsive to the Requirement for Information under the guidelines set forth for such a requirement in MPEP §704.11.

Examiner’s Improper Use of Notice of Non-Compliant Amendment Under 37 CFR 1.121

As stated above, Applicant respectfully believes that the Examiner’s use of a Notice of Non-Compliant Amendment under 37 CFR 1.121, regarding the replies filed on September 7, 2006, and January 11, 2007, is improper. While Applicant objected in part to the Requirement for Information imposed by the Examiner, no amendments were made to the current application in either response. Accordingly, the use of a Notice of Non-Compliant Amendment under 37

CFR 1.121 is improper and it is requested that such Notice be withdrawn. 37 CFR 1.121 is entitled “Manner of making amendments in applications” and sets forth rules governing the proper form and procedure for submitting amendments to an application. That is, it provides information on the proper manner to, and stylistic rules for, amending an application. A review of the Examiner’s Notice of Non-Compliant Amendment reveals that the reasons for such Notice, that Applicant failed to provide a listing of claims relevant to a possible double patenting issue, clearly departs from the substance of 37 CFR 1.121.

Furthermore, MPEP §714 sets forth when it is proper for an Examiner to send a Notice of Non-Compliant Amendment under 37 CFR 1.121 to an Applicant. MPEP §714 states that “[i]f an amendment... fails to comply with 37 CFR 1.121, the Office will notify applicant by a Notice of Non-Compliant Amendment, Form PTOL-324, that the amendment fails to comply with the requirements of 37 CFR 1.121...” MPEP §714(II)(F) (emphasis added). Therefore, per MPEP §714(II)(F), a Notice of Non-Compliant Amendment should only be prepared when there is an amendment that fails to comply with 37 CFR 1.121. No amendments were made in either of the responses of September 7, 2006 or January 11, 2007, and as such, the Examiner has provided no grounds for the issuance of a Notice of Non-Compliant Amendment under 37 CFR 1.121.

For these reasons, Applicant respectfully believes that the Notice of Non-Compliant Amendment under 37 CFR 1.121 is improper and should be withdrawn.

Response to Requirement for Information Under 37 CFR 1.105

In the Requirement for Information under 37 CFR 1.105 of June 7, 2006, the Examiner directed Applicant to disclose all co-pending applications and related patents that may be related to the current application. Responsive thereto, reasonable inquiries were made to those responsible under §1.56(c) and to the assignee of the present application, and a list was provided of those co-pending applications and patents believed to be relevant to examination of the current application.

The Examiner also directed Applicant to “identify the specific claims of those [related] applications and/or patents which may present double patenting issues with the instant application claims.” *Office Action, June 7, 2006, p. 2*. As stated in the replies filed September 7, 2006 and January 11, 2007, Applicant respectfully believes that imposing such a burden on a patent applicant is not proper and is overly broad. An examination of 37 CFR 1.105 reveals the purpose

of requirements for information and the limits to such requirements. As set forth in 37 CFR 1.105, “[r]equirements for factual information known to applicant may be presented in any appropriate manner...” (emphasis added). That is, as set forth in MPEP §704.11, “[t]he terms ‘factual’ and ‘facts’ are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that ***requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.***” MPEP §704.11 (emphasis added). From this, it is clear that any Requirement for Information under 37 CFR 1.105 should only seek to obtain facts from an applicant, not opinions. The requirement imposed on Applicant by the Examiner to identify specific claims of those applications or patents which may present double patenting issues with the instant application claims, is clearly requesting an opinion and is therefore contrary to the rule set forth in MPEP §704.11.

Additionally, MPEP §704.11(a) lists examples of information reasonably required to be provided by an applicant. At most, it appears that subsection (G) is most closely relevant to this issue, which states that information required for examination may include “[i]dentification of pending or abandoned applications filed by at least one of the inventors or assigned to the same assignee as the current application that disclose similar subject matter that are not otherwise identified in the current application.” *MPEP §704.11(a)(G)*. Applicant has so complied. MPEP §704.11(a) does not authorize an examiner to require an applicant to formulate opinions on potential double patenting claims in those related applications and/or patents. As stated above, MPEP §704.11 actually restricts an examiner from requiring an Applicant to formulate such opinions.

For these reasons, Applicant believes that the reply previously filed on September 7, 2006, is fully responsive to the Requirement for Information under 37 CFR 1.105 and that the Examiner has no support in either the CFR or MPEP for the continued requirement that Applicant identify specific claims which may present double patenting issues with the instant application claims. Furthermore, and despite the Examiner’s statement that “[t]he time period for response will continue to run from the mail date of the previous office action”, Applicant believes that the present response is in fact timely, as no subsequent proper Office Action has been issued since the Requirement for Information mailed June 7, 2006, which Applicant properly responded to on September 7, 2006. *See Office Action, April 11, 2007, p. 3.* Thus, Applicant believes no

extension fees are due for filing this response; however, should a fee be deemed necessary, Applicant hereby authorizes charging of Deposit Account No. 07-0845.

Applicant appreciates the Examiner's consideration of these Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

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